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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,783	03/16/2004	Victor I. Chormenky	1004.012	3117
7590	03/21/2006		EXAMINER TOY, ALEX B	
Law Offices P.O. Box 386353 Bloomington, MN 55438			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/801,783

Applicant(s)

CHORNENKY ET AL.

Examiner

Alex B. Toy

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 8-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Invention I in the reply filed on February 21, 2006 is acknowledged. Claims 15-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 1-14 are examined.

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the current drawings are informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Objections***

Claim 8 is objected to because of the following informalities: "generators" should be changed to "generates". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Dev (U.S. PGPub 2002/0099323 A1).

Regarding claim 1, Dev discloses an apparatus for providing hair removal therapy to a patient, said apparatus comprising:

a high voltage pulse generator (pg. 8, ¶ 92); and

an applicator electrically connected to said pulse generator, said applicator including a central electrode 120 and an outer electrode 210 surrounding the central electrode (pg. 8, ¶ 91 and Fig. 2),

wherein said generator supplies pulses to said electrodes to create a electroporating field (pg. 8, ¶ 92) causing hair follicle death when said central electrode is placed into contact with a hair follicle.

The preceding paragraph recites intended use. Since the structure of Dev anticipates the structure as claimed, the device of Dev is inherently capable of the claimed use.

Regarding claim 2, Dev discloses the apparatus of claim 1 wherein said central electrode 120 is a rod-like electrode (Fig. 2).

Regarding claim 3, Dev discloses the apparatus of claims 1 and 2 wherein said outer electrode 210 has an annular configuration (Fig. 2).

Regarding claim 4, Dev discloses the apparatus of claims 1-3 wherein said generator produces pulses having a duration exceeding 1 microsecond (pg. 10, ¶ 110).

Regarding claim 6, Dev discloses the apparatus of claim 1 wherein said central electrode 120 is a needle electrode (pg. 8, ¶ 91 and Fig. 2).

Regarding claim 7, Dev discloses the apparatus of claims 1 and 6 wherein said outer electrode has an annular configuration (Fig. 2).

Regarding claim 8, Dev discloses the apparatus of claims 1, 6, and 7 wherein said generator generates pulses having a duration exceeding 1 microsecond (pg. 10, ¶ 110).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dev ('323) in view of Bernard (U.S. Pat. No. 6,912,417 B1).

Regarding claim 5, Dev discloses the apparatus of claims 1-3. The claim differs from Dev in calling for said generator to produce pulses having a duration in the range of 0.1 nanosecond to 1 microsecond. Bernard, however, teaches an electroporating needle for delivering therapeutic agents into tissue, wherein a generator produces pulses having a duration in the range of 0.1 nanosecond to 1 microsecond (col. 12, ln. 21-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a pulse duration of 1 microsecond in the device of Dev in view of the teaching of Bernard as an obvious alternate pulse duration for delivering therapeutic agents into tissue that is known in the art.

In addition, applicant has not disclosed any criticality or unexpected result associated with this range that defines over the longer pulse durations disclosed by Dev. On page 12 of the specification, applicant recites that "pulse duration can be ... in the range of about .1 nanosecond to one microsecond or they can be longer than microsecond."

#### ***Allowable Subject Matter***

Claims 9-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5052391 A	USPAT	Silberstone; Leon M. et al.
US 5533999 A	USPAT	Hood; Larry et al.
US 5983131 A	USPAT	Weaver; James C. et al.
US 5999847 A	USPAT	Elstrom; John A.
US 6132419 A	USPAT	Hofmann; Gunter A.
US 6159163 A	USPAT	Strauss; Jonathan S. et al.
US 6261831 B1	USPAT	Agee; Forrest J.
US 6326177 B1	USPAT	Schoenbach; Karl H. et al.
US 20020010491 A1	US-PGPUB	Schoenbach, Karl H. et al.
US 6493592 B1	USPAT	Leonard; Paul et al.
US 20030225360 A1	US-PGPUB	Eppstein, Jonathan et al.
US 6697669 B2	USPAT	Dev; Nagendu B. et al.
US 20050049541 A1	US-PGPUB	Behar, Francine et al.

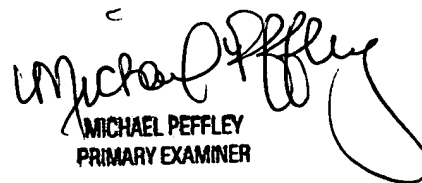
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AT AT  
3/15/06

  
MICHAEL PEFFLEY  
PRIMARY EXAMINER